

REMARKS

Claims 1-2 and 12-34 are now pending in this application. Claims 1, 2, and 12-23 are rejected. Claims 3-14 are objected to. Claims 3-11 are previously cancelled. New claims 24-34 are added. Claims 1, 2, and 12-21 are amended herein to clarify the invention. Claims 22 and 23 are amended herein to correct typographical errors. The specification has been amended to be in better form.

The Examiner objected to claims 3-14 because of claim dependency improprieties such as, for example, a multiple dependent claim depending on a multiple dependent claim. Claims 3-11 have been listed as cancelled and, therefore, their objection is moot. The dependency of claims 12-14 has been changed to depend from a non-cancelled claim. Applicant therefore respectfully requests the withdrawal of the objection to claims 12-14.

The Examiner suggested that the word comprising be used in claim 2. The Examiner's suggestion has been implemented.

Claims 2 and 15 have been objected to for failing to further limit the subject matter of a previous claim. Appropriate correction has been made and Applicant respectfully requests that the objection to claims 2 and 15 be withdrawn. The Examiner's suggestion regarding modifying claim 15 to read "or the sweetening agent" has been implemented.

Claim 19 has been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Appropriate correction has been made and Applicant respectfully requests that the rejection of claim 19 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claims 1, 2, 18, 20, and 21 have been rejected under 35 U.S.C. § 102(b) as anticipated by JP 60120950 (Sakuma). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Claim 1 is patentable over Sakuma at least for the reason that Sakuma fails to disclose caffeine and tourine, as recited in claim 1. Claim 2 is patentable over Sakuma at least for the reason that Sakuma fails to disclose trehalose. Claims 18, 20, and 21 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

In rejecting claims 20 and 21, the Office Action states that Sakuma discloses comprising a cola beverage and that a cola beverage inherently contains caramel syrup, caramel aroma, and caffeine. The Federal Circuit has stated that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the

reference. *See In re Robertson*, 59 USPQ2d 1949, 1950 (Fed. Cir. 1999).

However, the Office Action did not provide any extrinsic evidence to support the inherency arguments. Furthermore, even if the Office Action provided extrinsic evidence to support the inherency arguments, it should be noted that inherency may not be established by probabilities or possibilities and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *See In re Robertson*, 59 USPQ2d 1949, 1951 (Fed. Cir. 1999). In other words, for cola beverage to inherently contain caramel syrup, caramel aroma, and caffeine, it must be shown that it is not possible to have a cola beverage that does not contain caramel syrup, caramel aroma, and caffeine. No such showing has been made in the Office Action. Thus, the Office Action fails to meet the burden of showing inherency and, accordingly, claim 20 is further patentable over Sakuma at least because Sakuma does not disclose caramel syrup, as recited in claim 20. Claim 21 is also patentable over Sakuma at least for the reason that Sakuma fails to disclose lime aroma, as recited in claim 21. Claims 12-17, 19, and 22-34 are patentable at least for the reason that they depend from a patentable base claim. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 18, 20, and 21 under 35 U.S.C. § 102(b) as anticipated by JP 60120950 (Sakuma) be withdrawn, and that the patentability of claims 12-17, 19, and 22-34 over Sakuma be acknowledged.

Claims 1, 2, 15, 16, 18, 20, and 21 have been rejected under 35 U.S.C. § 102(a) as anticipated by DE 19736429 (Alvater). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Claim 1 is patentable over Alvater at least for the reason that Alvater fails to disclose tourine, as recited in claim 1. Claim 2 is patentable over Alvater at least for the reason that Alvater fails to disclose trehalose. Claims 15, 16, 18, 20, and 21 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974). The Office Action relies on inherency to reject claims 20 and 21. As stated above, the Office Action has not met the standard for inherency. Furthermore, Alvater fails to disclose lime aroma, as recited in claim 21. Claims 12-14, 17, 19, and 22-34 are patentable at least for the reason that they depend from a patentable base claim. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 15, 16, 18, 20, and 21 under 35 U.S.C. § 102(a) as anticipated by DE 19736429 (Alvater) be withdrawn and that the patentability of claims 12-14, 17, 19, and 22-34 over Alvater be acknowledged.

Claims 1, 2, 16, 20, and 21 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,197,325 (Ono et al.). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Claim 1 is patentable over Ono et al. at least for the reason that Ono et al. fails to disclose caffeine and tourine, as recited in claim 1. Claim 2 is patentable over Ono et al. at least for the reason that Ono et al. fails to disclose trehalose. Claims 16, 20, and 21 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974). The Office Action relies on inherency to reject claims 20 and 21. As stated above, the Office Action has not met the standard for inherency. Furthermore, Ono et al. fails to disclose lime aroma, as recited in claim 21. Claims 12-15, 17-19, and 22-34 are patentable at least for the reason that they depend from a patentable base claim. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 16, 20, and 21 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,197,325 (Ono et al.) be withdrawn and that the patentability of claims 12-15, 17-19, and 22-34 over Ono et al. be acknowledged.

Claims 1, 2, 16, 18, 20, and 21 have been rejected under 35 U.S.C. § 102(b) as anticipated by EP 0496426 (Fukuyama et al.). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Claim 1 is patentable over Fukuyama et al. at least for the reason that Fukuyama et al. fails to disclose caffeine and tourine, as recited in claim 1. Claim 2 is patentable over Fukuyama et al. at least for the reason that Fukuyama et al. fails to disclose trehalose. Claims 16, 18, 20, and 21 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974). The Office Action relies on inherency to reject claims 20 and 21. As stated above, the Office Action has not met the standard for inherency. Furthermore, Fukuyama et al. fails to disclose lime aroma, as recited in claim 21. Claims 12-15, 17, 19, and 22-34 are patentable at least for the reason that they depend from a patentable base claim. Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 16, 18, 20, and 21 under 35 U.S.C. § 102(b) as anticipated by EP 0496426 (Fukuyama et al.) be withdrawn and that the patentability of claims 12-15, 17, 19, and 22-34 over Fukuyama et al. be acknowledged.

Claims 17, 19, 22, and 23 have been rejected under 35 U.S.C. § 103(a) as obvious over Sakuma, Alvater, Ono et al., and Fukuyama in view of U.S. Patent No. 5,223,300 (Brinkers) and U.S. Patent No. 3,600,196 (Heine et al.).

The Office Action states that “Sakuma, Alvater, Ono et al., and Fukuyama all disclose the use of a cola beverage in a spread, which inherently contains water, sugar, caramel syrup, citric acid, cola aroma, and caramel aroma.” As stated above, the burden is on the Examiner to show the inherency of particular characteristics and that inherency requires that something must necessarily happen, not merely that it can happen. Thus, the Office Action has not met its burden of proving inherency.

The references cited by the Examiner fail to disclose or suggest all the limitations of claims 1 and 2 at least because there is no disclosure of tourine (see claim 1) or trehalose (see claim 2) in the cited art. Thus, claims 1 and 2 are patentable over the cited art since to establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03. Claims 17, 19, 22, and 23 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03. The Federal Circuit has stated that there must be suggestion or motivation to combine

references. *See In re Mills*, 16 USPQ 1430, 1432 (Fed. Cir. 1990) (emphasis added); MPEP § 2143.01. Regarding claim 17, the Office Action states that “Brinkers discloses the use of carob bean flour as thickener in a spread (example C).” However, there is no disclosure or suggestion in Brinkers that carob bean flour is being used as a thickener. Brinkers fails to disclose why carob bean flour is included in Example C and, accordingly, there is no motivation to combine the carob bean flour of Brinkers with any other reference because there is insufficient disclosure in Brinkers to provide any motivation to use carob bean flour as a thickener. In fact, on column 3, lines 40-44, Brinkers lists thickeners and gelling agents and noticeably fails to list carob bean flour. Thus, claim 17 is also patentable because all of its limitations are not disclosed or suggested in the prior art.

Regarding claim 19, the Office Action states that “Heine discloses the inclusion of nougat in a spread as a source of fat.” However, Heine fails to disclose what kind of nougat is being utilized in Heine while claim 19 recites, for example, almond nougat and nut nougat. Thus, Heine fails to disclose the recitations of claim 19. Even if Heine disclosed the type of nougat being recited in claim 19, Heine discloses nougat as a source of fat. The Office Action has not provided any reasoning as to why nougat fat from Heine would be desirable in any of the other references that have been cited. In other words, no motivation has been shown to use the nougat fat from Heine in other references. Thus, *prima*

facie obviousness has not been demonstrated. Accordingly, claim 19 is patentable for these reasons as well.

Regarding claim 22, the Office Action states that Sakuma discloses the inclusion of starch syrup. Applicant respectfully requests that the Examiner point out where starch syrup is listed in Sakuma. In any event, Sakuma fails to disclose or suggest all of the elements recited in claim 22 such as, for example, applesauce and lime aroma. In fact, the Office Action does not mention applesauce and lime aroma at all. Thus, claim 22 is patentable over the cited art for these reasons as well. Furthermore, none of the references discloses or suggests the ratios of ingredients recited in claim 22, further demonstrating the patentability of claim 22.

Regarding claim 23, the Office Action fails to discuss some of the ingredients of claim 23, such as isomalt and sorbite. Thus, *prima facie* obviousness has not been demonstrated. In any event, none of the references discloses or suggests the ratios of ingredients recited in claim 23, further demonstrating the patentability of claim 23. Claims 12-16, 18, 20-21, and 24-34 are patentable at least for the reason that they depend from a patentable claim. Accordingly, Applicant respectfully requests that the rejection of claims 17, 19, 22, and 23 under 35 U.S.C. § 103(a) as obvious over Sakuma, Alvater, Ono et al., and Fukuyama in view of U.S. Patent No. 5,223,300 (Brinkers) and U.S.

Patent No. 3,600,196 (Heine et al.) be withdrawn and that the patentability of claims 12-16, 18, 20-21, and 24-34 be acknowledged.

The Office Action, on page 7, cites *In re Levin*, 84 USPQ 232 (CCPA 1949) for the proposition that “[n]ew recipes of formulas for cooking food, which involve addition or elimination of common ingredients, or for treating them in ways which differ from former practice, do not amount to invention merely because it is not disclosed that no one else ever did what Applicant did; Applicant must establish co action or cooperative relationship between ingredients which produces new, unexpected and useful function.” The Federal Circuit has stated that to establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. See *In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03. Any interpretation of *In re Levin* that would deviate from the requirement that *prima facie* obviousness requires a showing that all the claim limitations are taught or suggested by the prior art is not an appropriate interpretation. Furthermore, the Federal Circuit has stated that the teaching of references can be combined *only* if there is some suggestion or incentive to do so. See *In re Fine*, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). Any interpretation of *In re Levin* that is inconsistent with the requirement for suggestion or incentive to combine references is also not an appropriate interpretation since it would be

inconsistent with the Federal Circuit's rulings. Accordingly, it is the burden of the U.S. Patent Office to demonstrate *prima facie* obviousness of each claim (including each element) before the Applicant is required to rebut *prima facie* obviousness by a showing of unexpected results. Any interpretation of *In re Levin* to the contrary would contravene well-established and court-approved principles of U.S. patent law. In any event, the current application is directed to the composition and method of manufacturing a spread and is not directed to cooking food. Just because an edible composition is disclosed in a patent application does not mean that the patent application is directed to cooking food.

The Office Action states, on page 7, that "[a]s all of the ingredients used in the spread claimed by Applicant were well known in the art of spreads, and no unexpected result has been provided, it would have been obvious to alter the amounts and specific combination in order to achieve a spread with a desired taste and texture." However, Applicant reiterates that *prima facie* obviousness has not been established. First, not all of the ingredients used in the spread claimed by Applicant have been demonstrated to be well known in the art of spreads, as described in the discussion above and including, for example, tourine and trehalose. Second, even if all of the ingredients recited in all of the claims of the above-identified application were shown to be well known in the art of spreads, the mandatory requirement of the Federal Circuit that a

suggestion or incentive be shown to combine references would have to be followed. Thus, there would have to be motivation for any combinations of any references. Third, the Office Action has not provided any evidence to show that “it would have been obvious to alter the amounts [of ingredients] and specific combination in order to achieve a spread with the desired taste and texture.” In any event, the invention is more than just “taste and texture,” as suggested in the Office Action. For example, the specification on page 1, sixth full paragraph states that an “object is to create a spread that stimulates circulation.” Additionally, the specification discloses a spread which has “properties protecting teeth and which do not have a laxative effect,” as described on the first full paragraph of page 2 of the specification. Additionally, in the paragraph bridging pages 3-4 of the specification is described a way to produce the spread easily and quickly. Thus, there are many advantageous characteristics of the invention of the above-identified application and *prima facie* obviousness has not been demonstrated regarding the claims of the above-identified application.

Applicant would like to note that the Office Action does not have checked all the necessary boxes regarding priority and the Examiner is respectfully requested to ensure that all the necessary boxes are checked.

Five claims in excess of twenty are added. **The fee of \$125.00 for the claims is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
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